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APPLICATION NO	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO	CONFIRMATION NO
10 015,905	12 05 2001	James W. Comer	47499 VGG C614	5799

23363 7590 03 06 2003

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EXAMINER

LOCKER, HOWARD J

ART UNIT PAPER NUMBER

1661

DATE MAILED: 03 06 2003

2

Please find below and/or attached an Office communication concerning this application or proceeding.



UNITED STATES DEPARTMENT OF COMMERCE  
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EXAMINER
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2

DATE MAILED:

This is a communication from the examiner in charge of your application.  
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

☒ Responsive to communication(s) filed on December 05, 2001

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire Three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ ~~The claim is~~ The claim is pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ ~~The claim is~~ The claim is rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☒ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of Reference Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s) \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

Notice of Informal Patent Application, PTO-152

-- SEE OFFICE ACTION ON THE FOLLOWING PAGES --

10/015905  
PTOL-326 (Rev. 10/95)

U.S. GOVERNMENT PRINTING OFFICE: 2001-4-247-4-1-1-1-1

i. The following is a quotation of section (a) of 37 CFR 1.163:

(a) The specification must contain as full and complete a disclosure as possible of the plant and the characteristics thereof that distinguish the same over related known varieties, and its antecedents, and must particularly point out where and in what manner the variety of plant has been asexually reproduced. In the case of a newly found plant, the specification must particularly point out the location and character of the area where the plant was discovered.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

"The specification shall contain a written description of the invention, and of the manner and process of making and using it in such full, clear, concise and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention."

In plant applications filed under 35 U.S.C. 161, the requirements of 35 U.S.C. 112 are limited. The following is a quotation of 35 U.S.C. 162:

No plant patent shall be declared invalid for noncompliance with section 112 of this title if the description is as complete as is reasonably possible. The claim in the specification shall be in formal terms to the plant shown and described.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

"The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention."

As specific to United States Plant Patent applications, the specifics of 37 CFR 1.164 (reproduced below) are controlling:

The claim shall be in formal terms to the new and distinct variety of the specified plant as described and illustrated, and may also recite the principal distinguishing characteristics. More than one claim is not permitted.

The disclosure is objected to under §7 CFR 1.163(a) and under §5 U.S.C. 112 first paragraph because the specification presents less than a full clear, and complete botanical description of the plant and the characteristics which define same per se, and which distinguish same over related or similar known cultivars and antecedents.

More specifically:

A As the specification states that the instant plant has been successfully asexually reproduced by budding, the specification should set forth the rootstock(s)/plants utilized. Such need not be in greater detail than setting forth the Genus/species of same.

B The botanical classification of the subject plant should be positively set forth in the specification.

C Upper surface leaf texture should be more fully accounted for. Such would appear to be properly characterized as glossy or semi-glossy per the submitted photographic illustration.

D Relative to foliage, size of the compound leaf should be accounted for in the specification. Additionally, relative to the recitation at lines 20-21 of page 3, the specification should be amended to include which leaflet in the compound leaf is being described (terminal or lateral). The measurements currently set forth relative to foliage size should likewise be reviewed for accuracy and appropriate correction provided if necessary.

E Relative to the recitation at line 22 of page 3, such should be broadened to account for a more accurate expression of the plant, particularly as a three leaflet leaf is illustrated. If by the above referenced recitation applicant intended to state that the compound leaf most often has five leaflets, the specification should so state.

F. The recitation (page 4, line 9) "Veination: None" does not make sense, and it is not clear what was intended. Correction and/or clarification is necessary.

G. The recitation currently set forth relative to flowering stem length should be reviewed for accuracy, particularly given the stated market class of the cultivar, and that the blooms are borne singly.

H. It is not clear what is intended or encompassed by the recitation appearing at line 21 of page 4, relative to temperature range. Correction and/or clarification is necessary.

I. Additional information relative to the sepals should be imported into the specification in the interest of providing as complete a botanical description of the plant as is reasonably possible, such as by stating if the sepals are typically characterized as having extensions. If such is the case the specification should discuss such, at least relative to number of sepals so characterized.

J. Peduncle characteristics should be more completely set forth, such as by accounting for the surface characteristics thereof, and coloration thereof other than the anthocyanin blush, as shown in the submitted photographic illustration.

K. It is not clear what is intended or encompassed by Persistence: Good" as recited at line 25 of page 5. Does this mean that the petals persist or that the petals drop?

L. Petaloid coloration should be accounted for in the specification.

M. Relative to petal texture as recited at line 11 of page 5, the recitation "Thin / soft" should be amended to "Thin, soft" (or similar) if that is what was intended.

N. Petal shape and margin should be more meaningfully described in the specification. In this regard, the outer petals of the open bloom illustrated would look to be properly characterized as being reflexed to a point, or similar. The present recitation of "Longer than wider" does not make sense.

N. The color designations currently set forth in the specification relative to petal coloration do not reasonably correspond to the plant as illustrated. Specifically, the petal coloration illustrated is several shades darker and is a much more intense orange-red than that represented by the RHS Color Designations set forth in the specification. However, the bud color designations currently set forth in the specification do in fact look to reasonably correspond to the open bloom illustrated. Correction and/or clarification is necessary.

If the source of the noted discrepancy is the submitted photographic illustration, it may be necessary for applicant to file a substitute therefor. Two copies of such must be furnished. Applicant's attention is directed to 37 CFR 1.165(a) and (b).

In addition, if the bloom color designations currently set forth in the specification are determined to be correct, it would be necessary for applicant to amend the generic bloom color designation in the written description and abstract as such would then not reasonably be characterized as orange.

O. Additional information should be imported into the specification relative to reproductive organs, such as by reciting an observed and characteristic numerical range therefore.

P. Prickles/thorns are not accounted for in any manner in the specification. Such should be accounted for at least relative to coloration, relative number, size, and aspect/shape.

Q. If more information is now available relative to characteristic and observed disease resistance/susceptibility, such should be imported into the specification in the interest of providing as complete a botanical description of the plant as is reasonably possible, particularly appears to be a garden or landscape hybrid tea cultivar.

R. The section of the specification entitled "BRIEF DESCRIPTION OF ILLUSTRATION" should be amended to more accurately reflect the contents of the photographic illustration. At present this section states that flowers are shown, while the illustration shows much more than just the flowers.

S. More substantive and meaningful information should be imported into the specification relative to stigmas. The current recitation of "Usual" states little.

The above listing may not be comprehensive. Applicant should carefully review the disclosure and import into same any additional or corrected information which would aid in botanically identifying and/or distinguishing the cultivar for which United States Plant Patent protection is being sought.

2 The claim is rejected under 35 U.S.C. 112, first and second paragraphs as not being supported by a clear and complete botanical description of the plant, for the reasons set forth in paragraph 1 above.

Serial No. 10/015905  
Art Unit 1661

-7-

3. Applicant is advised of the new optional procedures for amending the specification and claim under 37 CFR 1.121. The new procedures are optional until July, 2003, and such may become mandatory at that time. Applicant may review same on the internet at the following site:  
<http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/revamdtpra.htm>

4. Any inquiry concerning this communication from the examiner should be directed to Examiner Howard J. Locker whose telephone number is 703-308-2924, and whose normal work hours are Monday through Thursday, from 6:30 a.m. to 5:00 p.m.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Bruce Campell, can be reached at 703-308-4205.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is 703-308-0196.

### **TELECOPY/FACSIMILE TRANSMISSION**

Papers related to this application may be submitted to Group 1600 by facsimile transmission. Papers should be faxed to this Group via the PTO Fax Center in Crystal Mall 1 (CM 1). The faxing of such papers must conform to the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The CM 1 Fax Center number is 703-308-4556 or 703-305-3592.

Howard J. Locker/hjl  
March 04, 2003

  
HOWARD J. LOCKER  
EXAMINER  
TELE ART UNIT 1661